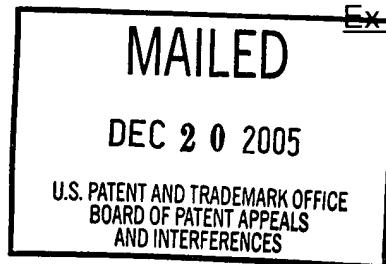


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte JAMES G. WHAYNE and SIDNEY D. FLEISCHMAN

Appeal No. 2005-1609
Application No. 09/507,613

ON BRIEF

Before McQUADE, NASE, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 10-13 and 15-37. Claims 1-9 have been canceled and claim 14 stands objected to as being dependent upon a rejected base claim but is otherwise indicated as allowable. No other claims are pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a catheter assembly for supporting one or more diagnostic or therapeutic elements in contact with body tissue, the catheter assembly having operably connected to its distal end a control element or pull wire. Independent claims 10 and 22 are representative of the invention and are reproduced, *infra*, in the opinion section of this decision.

The Applied Prior Art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Brennen et al. (Brennen)	5,439,006	Aug. 8, 1995 (filed Feb. 3, 1993)
Whayne et al. (Whayne)	6,071,279	Jun. 6, 2000 (filed Dec. 19, 1996) ¹

The Rejections

Claims 10-12, 15-23 and 27-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Whayne.

¹ The appellants urge in their brief that the Whayne patent is not prior art with respect to claims 10-12, 15-23 and 27-37 of the present application because the subject matter of these claims is entitled to the benefit of the filing date of December 19, 1996 of Application No. 08/769,856. The present application is a continuation of Application No. 08/961,374, which is a continuation-in-part of Application No. 08/769,856. In light of our determination, *infra*, that claims 10-12, 15-23 and 27-37 are not anticipated by Whayne and that the combination of Whayne and Brennen is insufficient to establish a *prima facie* case of obviousness of the subject matter of claims 13 and 24-26, we need not reach this issue.

Claims 13 and 24-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whayne in view of Brennen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 25, 2004) for the examiner's complete reasoning in support of the rejections and to the second supplemental appeal brief (hereinafter "brief" filed May 13, 2004) and reply brief (filed October 1, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Independent claims 10 and 22 read as follows.

10. A catheter assembly, comprising:

 a handle including a handle body and a strain relief element;

 an elongate catheter body defining a distal portion, a proximal portion associated with the handle, and a size and flexibility suitable for insertion into a human body; and

 a control element defining a distal portion operably connected to the distal portion of the catheter body and a

proximal portion extending along the exterior surface of the catheter body and secured to the strain relief element.

22. A catheter assembly, comprising:

a handle including a handle body;

an elongate catheter body defining a distal portion, a proximal portion associated with the handle, and a size and flexibility suitable for insertion into a human body;

a control element defining a distal portion operably connected to the distal portion of the catheter body and a proximal portion extending along the exterior surface of the catheter body; and

an apparatus, located in spaced relation to the handle body, adapted to secure the proximal portion of the control element in predetermined relation to the catheter body.

In rejecting independent claim 10 as being anticipated by Whayne, the examiner has taken the position that either Whayne's steering mechanism 68 (Figure 1; column 11, lines 45-57) or Whayne's stop 336, disposed on the proximal end of the pull wire 334 (Figure 53; column 28, lines 4-6) responds to the recited "strain relief element" (answer, page 3). The examiner's articulated basis for this position is that "[a]n operator using Whayne's steering mechanism 68 (strain relief element) causes to strain and release the strain of the wire, by applying forces on the proximal end of the wire due [to] the action of the steering mechanism 68" (answer, page 7). While the examiner has not specifically explained how the stop 336 meets the "strain relief element" limitation, we presume the examiner's rationale to be similar to that for the

steering mechanism 68, namely, that an operator using the stop 336 selectively strains and releases strain on the pull wire 334.

The appellants (brief, pages 9-21) argue that the examiner's interpretation of the phrase "strain relief element" as an element which strains and relieves strain is unreasonable in light of the use of that terminology in the appellants' specification and its analogous use in five patents from the field of catheters. We agree with the appellants. The examiner's breaking up of the phrase "strain relief element" into its components "strain," "relief" and "element" and simply interpreting the phrase as an element which strains and relieves strains is improper and inconsistent with the customary use of that terminology by those of ordinary skill in the art. While it is true that the claims in a patent application are to be given their broadest reasonable interpretation consistent with the specification during prosecution of a patent application (see, for example, In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), it is also well settled that terms in a claim should be construed as those skilled in the art would construe them (see Specialty Composites v. Cabot Corp., 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977). The evidence in this case is overwhelming that one of ordinary skill in the catheter art, consistent with the depiction of "strain relief element 21" (specification, page 42) in appellants' Figures 41 and 42, would have understood the phrase "strain relief element" as an element which secures or guides

cable or tube structures, such as catheters, to prevent them from being excessively strained or kinked at vulnerable regions, such as junctions with coupling members or handles. Neither the steering mechanism 68 nor the stop 336 of Whayne performs or is adapted to perform in this manner. Consequently, neither structure meets the "strain relief element" limitation of claim 10.

In light of the above, the rejection of independent claim 10 and claims 11, 12 and 15-21 depending from claim 10 as being anticipated² by Whayne cannot be sustained. As the examiner's application of Brennen fails to remedy the shortcomings of Whayne discussed above, it follows that the rejection of claim 13 depending from claim 10 as being unpatentable over Whayne in view of Brennen likewise cannot be sustained.

Independent claim 22 recites, *inter alia*, "an apparatus, located in spaced relation to the handle body, adapted to secure the proximal portion of the control element in predetermined relation to the catheter body." The examiner's position in rejecting claim 22 as being anticipated by Whayne is that either sheath 26 and/or gripping surface 36 thereof (Figure 1; column 9, lines 31-36) or sheath 304 (e.g., Figure 53; column 28, lines 4-6) responds to such apparatus because it is spaced from the handle 18 and "capable of securing the proximal portion of the control element 334 [or 66] in determined relation to the catheter body" (answer, pages 3-4). Inasmuch as both the

² To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

catheter and the steering wire 66 (or pull wire 334) slide freely through the sheath 26 (or 304), it is not apparent to us how Whayne's sheath is adapted to secure the proximal portion of the control element in predetermined relation to the catheter body as claimed and the examiner has provided no explanation as to why it is so adapted, despite the appellants' argument with respect to this issue on page 24 of their brief (see also reply brief, page 9).

In light of the above, the rejection of independent claim 22 and claims 23 and 27-37 depending from claim 22 as being anticipated by Whayne cannot be sustained. The examiner's application of Brennen provides no cure for the deficiency of Whayne discussed above. Accordingly, the rejection of claims 24-26 which depend from claim 22 as being unpatentable over Whayne in view of Brennan also cannot be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10-13 and 15-37 is REVERSED.

REVERSED


John P. McQuade
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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